

**REMARKS**

Claims 1 through 16 are pending in this Application. Applicants acknowledge, with appreciation, the Examiner's indication that claims 4 and 14 contain allowable subject matter. Accordingly, the only remaining issue pivots about the patentability of claims 1 through 3, 5 through 13, 15 and 16.

New claims 15 and 16 have been added. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, Fig. 7 and the related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue.

**Clarification of Record**

Applicants note the Examiner acknowledged receipt of the Information Disclosure Statement (IDS) and provided a partially initialed copy of Form PTO-1449 indicating consideration of the U.S. and foreign patent documents. However, under "OTHER ART", a publication was submitted, but the Examiner did not provide initials in the appropriate space to indicate consideration of that publication. Accordingly, the Examiner is requested to clarify the record by providing an appropriately initialed copy of Form PTO-1449 indicating consideration of each of the references cited therein, including the written publication.

**Claims 1 through 3 and 5 through 13 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by UK 2,062,615 (UK '615).**

In the statement of the rejection the Examiner referred to the sixth embodiment appearing at page 8 of UK '615, asserting the disclosure of a method and apparatus corresponding to those claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There are significant differences between the claimed method and apparatus on the one hand, and the method and apparatus disclosed by UK '615 on the other hand, that scotch the factual determination that UK '615 discloses a method and apparatus identically corresponding to those claimed.

Firstly, it should be apparent that the sixth embodiment of UK '615 on the other hand, does not employ a thermal plasma torch having a device for applying a high frequency electric field as in the claimed method and apparatus. Further, it is also apparent that the size of the flame 72 in Fig. 7, representing the relied upon sixth embodiment, is not varied even though the gases are varied. This is because the gases are supplied from pipes in the silicate glass tube 71, referring to page 8 of UK '615, lines 50 through 64.

To whatever extent the Examiner tacitly relied upon the doctrine of inherency, Applicants would stress that the Examiner must provide a factual basis upon which to predicate the determination that an allegedly inherent result **necessarily** flows from the teachings of the

applied prior art. No such factual basis has been established to support the requisite certainty.

*Crown Operations International Ltd. v. Solutia Inc., supra; Electro Medical Systems S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991).*

It is also not apparent wherein the seventh embodiment of UK '615 discloses or suggests the notion of varying the size of the flame, as in the claimed invention.

The above argued differences between the claimed inventions and the method and apparatus disclosed by UK '615 undermine the factual determination that UK '615 discloses a method and apparatus identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).* Applicants, therefore, submit that the imposed rejection of claims 1 through 3 and 5 through 13 under 35 U.S.C. § 102 for lack of novelty as evidenced by UK '615 is not factually viable and, hence, solicit withdrawal thereof.

**New claims 15 and 16.**

New claims 15 and 16 are clearly free of the applied prior art by virtue of their dependence upon independent claims 1 and 12, respectively, the patentability of which has been argued *supra*.

Moreover, Applicants separately argue the patentability of claims 15 and 16. Specifically, it is not apparent wherein UK '615 discloses or suggests a method or apparatus as

defined in each of claims 15 and 16, which requires heating the body from the outside of the body using a plasma torch with a high-frequency electric field. Accordingly, claims 15 and 16 are clearly free of the applied prior art.

Applicants again acknowledge, with appreciation, the Examiner's indication that claims 4 and 14 contain allowable subject matter. Based upon the arguments submitted *supra*, it should be apparent that the imposed rejection has been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Arthur J. Steiner  
Registration No. 26,106

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 AJS:bjs:ntb  
Facsimile: 202.756.8087  
Date: January 21, 2005

**Please recognize our Customer No. 20277  
as our correspondence address.**